

REMARKS / ARGUMENTS

I. General Remarks and Remarks Regarding the Restriction Requirement

Please consider the application in view of the following remarks.

On June 16, 2005, during a telephone conversation with the Examiner, claims 1-22 were provisionally elected in response to the Examiner's restriction requirement. This provisional election is hereby confirmed and claims 23-56 have been cancelled. No amendment to inventorship is necessitated by this election. Applicant respectfully reserves the right to present the cancelled claims in one or more divisional applications.

II. Disposition of Claims

Claims 1-22 are pending in this application. Claims 23-56 have been cancelled herein.

Claims 2, 12, 20, and 22 have been amended herein to correct some claim informalities and to more clearly claim the present invention. These amendments add no new matter to the application, and are supported by the specification as filed.

Claim 20 stands rejected under 35 U.S.C. § 112. Claims 1-7, 12, 13, 16, 17, and 21 stand rejected under the judicially created doctrine of obviousness-type double patenting. Claims 1-9, 12-17, 21, and 22 stand rejected under 35 U.S.C. § 102(e). Claims 1-8, 12, 13, 16, 17, 21, and 22 stand rejected under 35 U.S.C. § 102(b). Claims 10, 11, 14, and 15 stand rejected under 35 U.S.C. § 103(a). The Examiner has objected to claims 9, 18, and 19.

III. Rejections of Claims

A. Rejections of Claims Under 35 U.S.C. § 112

Claim 20 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. (*See* Office Action at ¶ 7.) With respect to this rejection, the Examiner writes that “[c]laim 20, in calling for the gel breaker to be added . . . to the coating composition ‘just prior to pumping the pre-coated proppant particulates down hole’ is deemed to conflict with parent claim 1 wherein the complete coating composition is emplaced on the proppant particles prior to any mixing with the fracturing fluid and pumping into the well bore.” (Office Action at ¶ 7.) In this Response, Applicant has amended claim 20 to omit the language that the Examiner noted to be in conflict with parent claim 1. The Examiner stated in the Office Action that claim 20 would be allowable if rewritten to overcome the rejections under 35 U.S.C.

§ 112, second paragraph, set forth in the Office Action. (*See* Office Action at ¶ 18.) Therefore, Applicant respectfully requests the withdrawal of this rejection, and asserts that claim 20 is now in condition for allowance.

B. Rejections of Claims Under Doctrine of Double Patenting

Claims 1-7, 12, 13, 16, 17, and 21 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6,887,834 to Nguyen *et al.* (*See* Office Action at ¶ 9.) Submitted herewith is the appropriate Terminal Disclaimer in compliance with 37 C.F.R. § 1.321 disclaiming the appropriate term. Accordingly, Applicant respectfully submits that the double-patenting rejection over this patent has been overcome, and respectfully requests the withdrawal of these rejections.

C. Rejections of Claims Under 35 U.S.C. § 102(e)

Claims 1-9, 12-17, 21, and 22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,887,834 to Nguyen *et al.* (“the '834 Patent”). In order to form a basis for a § 102(e) rejection, the earlier patent or patent application must be “by another.” *See* 35 U.S.C. § 102(e). Submitted herewith is Applicant’s declaration under 37 C.F.R. § 1.132 showing that the relevant disclosure in the '834 Patent is Applicant’s own work, and thus the invention disclosed therein is not by “another.” *See* MANUAL OF PATENT EXAMINING PROCEDURE § 716.10 (2004) (declaration from the applicant regarding the subject matter disclosed in a patent is sufficient to establish inventorship). Accordingly, Applicant respectfully submits that the 35 U.S.C. § 102(e) rejection of claims 1-9, 12-17, 21, and 22 based on the '834 Patent has been overcome, and respectfully requests the withdrawal of these rejections.

D. Rejections of Claims Under 35 U.S.C. § 102(b)

Claims 1-8, 12, 13, 16, 17, 21, and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,311,773 to Todd *et al.* (“*Todd*”). With respect to this rejection, the Examiner writes:

[*Todd*] (note col. 3, line 47 - col. 4, line 54) discloses a process of forming one or more fractures in a subterranean zone utilizing a gelled fracturing fluid containing proppant particles which are pre-coated with a coating composition comprising a hardenable resin, a silane coupling agent and a gel breaker. Upon emplacement of the coated proppants into the fracture(s), the resin component is hardened or set by the heat of the formation such that the proppants

are consolidated to form a permeable pack, as called for in independent claims 1 and 22.

(Office Action at ¶ 12.) Applicant respectfully disagrees.

In order to form a basis for a rejection under 35 U.S.C. § 102(b), a prior art reference must disclose each and every element as set forth in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004). Applicant respectfully submits that *Todd* does not teach or suggest a method that includes providing proppant particles pre-coated with a coating composition comprising a hardenable organic resin, a silane coupling agent and a gel breaker, as recited by claims 1 and 22. The passage in *Todd* cited by the Examiner (col. 3, line 47 - col. 4, line 54) does disclose the composition of certain resin compositions, but does not discuss any method in which proppant particles are pre-coated with such compositions prior to their use in a subterranean formation or treatment fluid. Rather, the portion of *Todd* that does discuss methods of use only teaches methods “utilized to resin coat and consolidate particulate solids already in a subterranean zone,” and methods wherein “uncoated particulate solids . . . are combined with the carrier fluid followed by the hardenable resin composition,” and the “suspended particulate solids are coated with the hardenable resin composition.” (*Todd* at col. 8, ll. 20-67 (emphasis added).) Therefore, *Todd* only teaches proppant particulates that are coated with a coating composition either once they are placed in a subterranean zone and/or after they are suspended in a carrier fluid. In contrast, Applicant’s invention requires that the proppant particulates be pre-coated with a coating composition before they are mixed into a fracturing fluid or placed in a subterranean zone, as recited in claims 1 and 22. *Todd* does not teach this limitation.

Applicant therefore respectfully asserts that *Todd* does not disclose all elements of claims 1 and 22, and thus these claims are allowable over *Todd*. Moreover, since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claims 2-8, 12, 13, 16, 17, and 21 depend from claim 1, these dependent claims are allowable for at least the same reasons. See 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicant respectfully requests the withdrawal of these rejections.

E. Rejections of Claims Under 35 U.S.C. § 103(a)

1. Rejection of Claim 10

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Todd* in view of U.S. Patent No. 5,609,207 to Dewprashad *et al.* (“*Dewprashad*”). Applicant

respectfully disagrees. To form a basis for a § 103(a) rejection, a combination of prior art references must teach or suggest each element in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2142 (2004). As discussed in Section III.D. above, *Todd* does not teach or suggest a method that includes providing proppant particles pre-coated with a coating composition comprising a hardenable organic resin, a silane coupling agent and a gel breaker, as recited in claim 1. Nor does *Dewprashad* teach or suggest these limitations, as *Dewprashad* merely teaches the preparation and use of certain types of epoxy resin systems for use in subterranean formations. (See *Dewprashad* at col. 1, ll. 40-52.) Because the combination of *Todd* and *Dewprashad* does not teach this element of claim 1, the combination cannot obviate claim 1. Since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claim 10 depends from claim 1, claim 10 includes the limitations of claim 1 that neither *Todd* nor *Dewprashad* teaches or suggests. See 35 U.S.C. § 112 ¶ 4 (2004). Therefore, Applicant respectfully asserts that claim 10 is allowable over the combination of *Todd* and *Dewprashad*, and respectfully requests the withdrawal of this rejection.

2. Rejection of Claim 11

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Todd* in view of U.S. Patent No. 5,253,711 to Mondshine (“*Mondshine*”). Applicant respectfully disagrees. To form a basis for a § 103(a) rejection, a combination of prior art references must teach or suggest each element in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2142 (2004). As discussed in Section III.D. above, *Todd* does not teach or suggest a method that includes providing proppant particles pre-coated with a coating composition comprising a hardenable organic resin, a silane coupling agent and a gel breaker, as recited in claim 1. Nor does *Mondshine* teach or suggest these limitations, as *Mondshine* merely teaches methods and compositions for breaking fluids and decomposing polymers used in subterranean formations. (See *Mondshine* at col. 2, ll. 50-56.) Because the combination of *Todd* and *Mondshine* does not teach this element of claim 1, the combination cannot obviate claim 1. Since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claim 11 depends from claim 1, claim 11 includes the limitations of claim 1 that neither *Todd* nor *Mondshine* teaches or suggests. See 35 U.S.C. § 112 ¶ 4 (2004).

Therefore, Applicant respectfully asserts that claim 11 is allowable over the combination of *Todd* and *Mondshine*, and respectfully requests the withdrawal of this rejection.

3. Rejection of Claims 14 and 15

Claims 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Todd* in view of the '834 Patent. Applicant respectfully traverses these rejections because the '834 Patent is not available as prior art under 35 U.S.C. § 103(a). Section 103(c) provides that “[s]ubject matter developed by another person, which qualifies as prior art only under [§ 102(e)] shall not preclude patentability under [§ 103(a)] where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” 35 U.S.C. § 103(c). Because the '834 Patent issued after the filing date of the present application it is only available as a prior art reference under § 102(e). The present application and the '834 Patent were, at the time the invention of present application was made, both owned by Halliburton Energy Services, Inc. As the present application was filed on or after November 29, 1999, Applicant’s statement of common ownership at the time the invention of the present application was made is sufficient to remove prior art from the purview of § 103(a) since that prior art would have been prior art only under § 102(e). *See* MANUAL OF PATENT EXAMINING PROCEDURE § 706.02(l)(2). Accordingly, the '834 Patent is no longer available as prior art under § 103(a) in accordance with § 103(c). Thus, Applicant respectfully requests the withdrawal of the § 103(a) rejections against claims 14 and 15.

IV. Objections to Claims

The Examiner has objected to claims 9, 18, and 19 as being dependent upon as being dependent upon a rejected base claim. (*See* Office Action at ¶ 19.) Claims 9, 18, and 19 each depend from independent claim 1. As Applicant has asserted herein that claim 1 is allowable over the prior art of record, the withdrawal of the objections to dependent claims 9, 18, and 19 is respectfully requested.

SUMMARY

In light of the above remarks, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections. Applicant further submits that the application is now in condition for allowance, and earnestly solicits timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

The Commissioner is hereby authorized to debit the Deposit Account of Halliburton Energy Services, Inc., No. 08-0300 in the amount of \$130.00 for the terminal disclaimer fee under 37 C.F.R. § 1.20(d). Should the Commissioner deem that any additional fees are due, including any fees for extensions of time, Applicant respectfully requests that the Commissioner accept this as a Petition Therefor, and directs that any additional fees be charged to the Deposit Account of Halliburton Energy Services, Inc., No. 08-0300.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert A. Kent", written over a horizontal line.

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